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WASHINGTON DC 20007

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OFFICE OF PETITIONS

In re Application of :
Benneker et al. :
Application No. 09/200,743 : LETTER REGARDING
Filed: November 30, 1998 : PATENT TERM ADJUSTMENT
Atty Docket No. 091856-0111 :

This is in response to the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT," filed October 1, 2008. Pursuant to their duty of candor and good faith to the Office, applicants disclose that the initial determination of patent term adjustment under 35 USC 154(b) disagrees with their calculation.

The request for review of patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two thousand fifty-seven (2057) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 19, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application¹. The Notice stated that the patent term adjustment (PTA) to date is 3148 days. Applicants do not state

¹ By virtue of the filing of a continued prosecution application (CPA) filed under 37 CFR 1.53(d) on November 27, 2000, the application became entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705.

a basis for their assertion that their patent term adjustment calculation disagrees with the Office's calculation.

Nonetheless, a review of the record reveals a basis for correction. 37 CFR 1.702(a)(3) provides that the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application;

37 CFR 1.703(a)(5) provides that:

The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

As stated in the Final Rule² and in pertinent part in MPEP 2731,

For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 134" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must sustain or reverse the rejection(s) of the claim(s) on appeal. For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 135" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must include a decision on the patentability of the claims or priority of invention. A remand or other administrative order by the Board of Patent Appeals and

² See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

Interferences (even if by a merits panel) is not a "decision" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)).

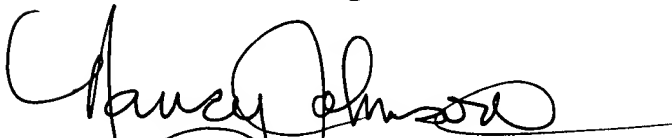
In this instance, such a favorable decision by the Board was mailed on May 25, 2004. The Office did not mail an Office action, a notice of allowance, in response until September 19, 2008, four months and 1455 days later. Pursuant to 37 CFR 1.703(a)(5), a period of adjustment of 1455 days should have been entered. Instead a period of adjustment of 2,546 days was entered. The period of adjustment of 2,546 days is being removed and the period of adjustment of 1455 days is being entered.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two thousand fifty-seven (2057) days.

As this letter was submitted as an advisement to the Office of an error in applicants' favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Office of Data Management for issuance of the patent. Any further period of adjustment accrued pursuant to 37 CFR 1.702(a)(4) and 1.702(b) will be reflected in the patent term adjustment shown on the issue notification letter mailed approximately three weeks prior to the issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a long horizontal flourish extending to the right.

Nancy Johnson,
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

PTA Calculations for Application: 09/200743

Application Filing Date:	11/30/1998	PTO Delay (PTO):	3148
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	0
Post-Issue Petitions:	0	Total PTA (days):	2057
PTO Delay Adjustment:	-1091		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
78	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	1455		
77	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		2546	
65	09/19/2008	MAIL NOTICE OF ALLOWANCE	2546		33
64	09/17/2008	ISSUE REVISION COMPLETED			
63	09/17/2008	DOCUMENT VERIFICATION			
62	09/17/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
61	09/15/2008	NOTICE OF ALLOWABILITY			
58	04/16/2008	MAIL-PETITION DECISION - GRANTED			
57	04/16/2008	PETITION DECISION - GRANTED			
56	03/17/2008	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
55	03/13/2008	CORRESPONDENCE ADDRESS CHANGE			
54	09/18/2007	PETITION ENTERED			
53	07/11/2007	MAIL-PETITION DECISION - DISMISSED			
51	11/20/2006	PETITION ENTERED			
49	05/25/2004	INTERFERENCE DISPATCH TO TC			
48	03/09/2005	CORRESPONDENCE ADDRESS CHANGE			
47	05/25/2004	MAIL INTERFERENCE DECISION - FAVORABLE			
46	05/25/2004	INTERFERENCE DECISION ON PRIORITY - FAVORABLE	602		44
45	11/28/2003	CORRESPONDENCE ADDRESS CHANGE			
44	10/01/2002	DECLARATION OF INTERFERENCE			
43	09/20/2002	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
42	09/19/2002	MISCELLANEOUS COMMUNICATION TO			

		APPLICANT - NO ACTION COUNT			
41	07/10/2002	INTERFERENCE COMMUNICATION: INITIAL MEMO DISPOSAL			
40.7	03/20/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	03/20/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	12/30/2001	FAOM FLAG CHANGE			
38	08/28/2001	MISCELLANEOUS INCOMING LETTER			
36	08/02/2001	MAIL LETTER SUSPENDING PROSECUTION AT APPLICANT'S REQUEST			
35	08/02/2001	LETTER OF SUSPENSION - APPLICANT INITIATED			
34	06/09/2001	DATE FORWARDED TO EXAMINER			
33	05/31/2001	RESPONSE TO ELECTION / RESTRICTION FILED			
32	04/26/2001	MAIL RESTRICTION REQUIREMENT			
31	04/26/2001	REQUIREMENT FOR RESTRICTION / ELECTION			
30	04/26/2001	CORRESPONDENCE ADDRESS CHANGE			
29	02/21/2001	MAIL SUSPENSION DUE TO INTERFERENCE IN ANOTHER APPLICATION			
28	02/21/2001	LETTER OF SUSPENSION - INTERFERENCE IN ANOTHER CASE			
27	02/21/2001	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
26	02/21/2001	MISCELLANEOUS ACTION WITH SSP			
25	02/13/2001	TERMINAL DISCLAIMER APPROVED IN TC			
24	01/31/2001	TERMINAL DISCLAIMER FILED			
23	01/31/2001	LETTER REQUESTING SUSPENSION OF PROSECUTION			
22	01/31/2001	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
21	12/14/2000	DATE FORWARDED TO EXAMINER			
20	11/27/2000	SUPPLEMENTAL RESPONSE			
19	12/14/2000	DATE FORWARDED TO EXAMINER			
18	11/27/2000	CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA)			
17	11/27/2000	MAIL EXPRESS ABANDONMENT (DURING EXAMINATION)			
16	11/27/2000	EXPRESS ABANDONMENT (DURING EXAMINATION)			
		REQUEST FOR EXTENSION OF TIME - GRANTED			

15	11/27/2000			
14	11/27/2000	WORKFLOW - REQUEST FOR CPA - BEGIN		

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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